



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q62188

Masayuki KONDO

Appln. No.: 09/732,787

Group Art Unit: 2833

Confirmation No.: 2734

Examiner: Felix O. FIGUEROA

Filed: December 11, 2000

For: WATERPROOFING APPARATUS FOR TERMINAL CONNECTING PORTION OF
SHEATHED WIRE

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated May 5, 2004. Entry of this Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

In the Appeal Brief, Appellant made several arguments regarding the patentability of claims 4 and 6-8 over the applied references. In the Examiner's answer, the Examiner summarizes the Appellants arguments, and responds thereto. Appellant submits the following response to the argument made in the Examiner's Answer.

I. Grouping of Claims

In numbered paragraph (7) on page 2 of the Examiner's Answer, the Examiner states,

The Appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Appellant has failed to provide reasons as why claims 6 and 8 do not stand or fall together with claim 4 and 7, as set forth in 37 C.F.R. § 1.192(c)(7) and (c)(8). Further, the Brief merely recites that "claims 6 and 8 are patentable at least by virtue of their dependency from claim 4", and the Appellant has not presented any separate arguments to distinguish the claims from the prior art of record. Accordingly, claims 4 and 6-8 will be treated as a single group.

In response, Applicant submits that claims 6 and 8 contain subject matter that renders these claims separately patentable from claims 4 and 7. This is at least implicitly admitted by the Examiner by the fact that the Examiner applies a separate third reference, Hauchard, to support the rejections of claims 6 and 8, in addition to the two references, the APA in Fig. 6 and Gerrans, applied against claims 4 and 7.

II. Arguments

In the Response to Argument section on pages 4-7 of the Examiner's Answer, the Examiner alleges, in summary, that combining or modifying the teachings of the APA in view of Gerrans was motivated by the knowledge generally available to one of ordinary skill in the art, and that it would have been evident to one skilled in the art that a contoured shape, as allegedly taught by Gerrans, provides a smoother gripping by avoiding substantially sharp or pointy edges that may be uncomfortable to a user's hand. In response, Appellant maintains, as previously argued, that nowhere does Gerrans teach or suggest that the alleged molded portion of Gerrans provides a smoother gripping¹, even if, assuming arguendo, the outer covering of Gerrans does

¹ Appellant believes that the Examiner intends to indicate that the molded portion is better able to be held by using the words "smoother gripping".

not have sharp or pointy edges. *See also arguments in Appeal Brief.* Further, even if, *assuming arguendo*, the outer covering of Gerrans does provide a smoother gripping (based on the definition of “smooth” as detailed in the Examiner’s Answer on page 6, first full paragraph), it would not necessarily follow such alleged smoother gripping would result in a user wanting to grip the outer covering. For instance, if the outer covering is smooth, one skilled in the art likely would NOT want to use the outer covering to hold, grip, pull, etc., as it may not provide adequate friction for gripping. If the outer covering is smooth, as the Examiner alleges, it is likely that one skilled in the art would NOT grip the outer covering.

Further, in the previously filed Appeal Brief, it was argued that “nowhere does Gerrans discuss something or someone holding or gripping the outer covering 16 of Gerrans.” The Examiner alleges, in response, that “all removable connectors (for example, as shown by Gerrans and the APA) are required to be manipulated/handled by either someone or something to perform/complete an electrical connection. In response, Applicant submits even if, *assuming arguendo*, all the movable connectors are required to be manipulated/handled by either someone or something to perform/complete an electrical connection, one skilled in the art would not have been led to believe that the outer covering 16 portion would be the portion used for holding or gripping the electrical connector of Gerrans. Moreover, nowhere does Gerrans disclose that the outer covering 16 would be a portion that a user would use to grip the electrical connector. For example, one might grip or hold the electrical connector of Gerrans as shown in Fig. 1, by the foundation portion 9, which is also shown in Fig. 1.

Further, to support the allegation that the outer covering 16 is the holding portion of the electrical connector of Gerrans, at the bottom of page 6 of the Examiner's Answer, the Examiner alleges "it is noted that based on the location of the housing (closest to the interface) and its relative rigidity (normally stiffer than the cable to which it is attached) the over mold portion/housing provides the stability required to align and guide the connector towards the mating connector." In response, based on the Examiner's own argument as set forth above, the foundation portion 9 would appear to be the portion of the electrical connector that a user would hold, as this portion is located "closest to the interface", and could be used to align and guide the connector towards the mating connector. The foundation portion 9 is different from the outer covering 16, which corresponds to the claim molded portion according to the Examiner. Therefore, the Examiner's argument appears to be inconsistent, as the Examiner alleges that the outer covering 16 corresponds to the claimed molded portion, however, based on the Examiner's argument in the paragraph at the bottom of page 6, the outer covering 16 would not be the portion of the electrical connector of Gerrans that one would hold; the foundation portion 9 would be the portion of Gerrans that would be held, as this portion is located nearest to the interface and it would provide the stability required to align and guide the connector towards the mating connector. That is, in summary, the Examiner's argument at the bottom of page 6 of the Examiner's Answer implies that the outer covering 16 would not be held by the user; the Examiner's argument implies that the foundation portion 9, which is different from the outer covering 16, would be the portion that would be held. Therefore, as previously argued, the Examiner's arguments are not consistent, and therefore cannot support the Examiner's rejections of claims 4 and 6-8.

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At least based on the arguments set forth above and the arguments set forth in the previously filed Appeal Brief, it is respectfully submitted that the Examiner has not satisfied the burden of establishing that each and every limitation of the claimed invention is satisfied by the applied references. It is also respectfully submitted that the Examiner's arguments are not consistent, and do not support his rejections of the pending claims.

In summary, Appellant traverses the rejections of the claims during prosecution and the arguments set forth in the Examiner's Answer, as set forth above and in Appellant's Brief on Appeal, and Appellant believes that these arguments render the claimed invention patentably distinguishable over the applied references.

CONCLUSION

For the above reasons as well as the reasons set forth in Appellant's Brief on Appeal, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on appeal. An early and favorable decision on the merits of this appeal is respectfully requested.

Respectfully submitted,



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CUSTOMER NUMBER

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